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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,282	07/22/2003	Frederick G. Payne	54593-2	7900
23994	7590	12/06/2005	EXAMINER	
JOSEPH W MOTT JENNINGS STROUSS & SALMON PLC 201 EAST WASHINGTON STREET 11TH FLOOR PHOENIX, AZ 85004-2385			KATCHEVES, BASIL S	
		ART UNIT		PAPER NUMBER
		3635		
DATE MAILED: 12/06/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/625,282	PAYNE, FREDERICK G.	
	Examiner Basil Katcheves	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 November 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-5 and 10-12 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-5,10-12 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

In response to the Pre-Appeal Brief Request dated 11/3/05, a new office action has been issued for this application and is below. Claims 6, 7, 8 and 9 are cancelled and claims 1-5, and 10-12 are pending.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,913,780 to Goergen.

Regarding claim 1, Goergen discloses a method of discouraging the roosting of birds by identifying a roosting zone (column 1, lines 4-10), and then applying a slide (fig. 4: 30) which imposes a plurality of angled surfaces (fig. 4: F & 30) to inhibit a bird's standing. Regarding the "formed" limitation, applicant should note that determination of patentability is based on the method itself. The patentability of a method does not depend on an article's method of production (in this case "formed"). If the article in the method claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

Regarding claim 2, Goergen discloses the use of a polyhedron with a plurality of exposed faces (fig. 2: face and ends).

Regarding claim 3, Goergen discloses the use of a triangular prism shape (fig. 2).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4, 5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,913,780 to Goergen.

Regarding claims 4, 5 and 10, Goergen discloses the method of discouraging the roosting of birds by identifying a roosting zone and applying a slide sheet to the roosting zone which inhibits a bird's roosting. Goergen does not disclose these various embodiments of shapes. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Goergen by using any suitable shape to deter birds, as the shape of the bird deterrent is not critical to the **method** of deterring birds, as being claimed, which is met by Goergen.

Regarding claim 11, Goergen discloses a method of discouraging the roosting of birds by identifying a roosting zone (column 1, lines 4-10), and then applying a slide (fig. 4: 30) which imposes a plurality of angled surfaces (fig. 4: F & 30) to inhibit a bird's standing on building structures, such as ledges. Roof structures inherently contain ledges to prevent any person or object from sliding off. Regarding the "formed"

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limitation, applicant should note that determination of patentability is based on the method itself. The patentability of a method does not depend on an article's method of production (in this case "formed"). If the article in the method claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. Goergen does not particularly disclose the slope angle of the slide. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify

Goergen by using any slope desired, as the slope of the slide is not critical to the **method** being claimed. The limitations of the **method** are met by Goergen.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,913,780 to Goergen in view of U.S. Patent No. 6,546,676 to Wiesener et al.

Regarding claim 12, Goergen discloses the device as meeting the roosting zone (fig. 2: see device 30 mounted to zone L) and the use of an adhesive (abstract). However, Goergen does not disclose the adhesive as being made of silicone and applied along a periphery. Wiesener discloses a bird repelling device secured to a structure through the use of a silicone adhesive (column 3, lines 14-16). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Goergen by using silicone adhesive, as disclosed by Wiesener, along the periphery of the device in order to create a weather resistant seal in order to prevent

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water from entering the underside of the device similar to the manner of which bath tubs, sinks, etc are caulked along their peripheries.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Basil Katcheves whose telephone number is (571) 272-6846. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman, can be reached at (571) 272-6842.

BK



Basil Katcheves

12/01/05

Examiner AU 3635